

BOSE McKINNEY & EVANS LLP



25267

PATENT, TRADEMARK OFFICE

2700 First Indiana Plaza  
135 North Pennsylvania Street  
Indianapolis, Indiana 46204  
(317) 684-5000

2652

COPY OF PAPER FILED  
ORIGINAL FILED  
PTO  
10/039,342  
11/19/01



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

App: 2632

Atty. Docket: 8266-0738

Applicants: Borders et al.

Invention: COMMUNICATION AND  
DATA ENTRY DEVICE

Serial No.: 10/039,342

Filed: November 19, 2001

Examiner: Unknown

Certificate Under 37 C.F.R. § 1.8(a)

I hereby certify that this correspondence is being  
deposited with the United States Postal Service as first  
class mail in an envelope addressed to the Commissioner  
for Patents, Washington, D.C. 20231

on March 5, 2002

*Timothy E. Niednagel*  
Timothy E. Niednagel

Dated: March 5, 2002

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents  
Washington, D.C. 20231

RECEIVED

MAR 20 2002

Technology Center 2600

Dear Sir:

This statement is filed in the application identified above pursuant to 37 CFR §§ 1.56, 1.97 and 1.98. Applicant calls attention to the art references within the knowledge of applicant and its attorney which are listed on the attached PTO Form 1449. The listed references were cited in parent U.S. application serial no. 09/187,696. Therefore, copies of the listed references are not required pursuant to 37 C.F.R. § 1.98(d). No representation is intended that a complete search has been made or that no better art references are available. The filing of this statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to the patentability as defined in 1.56(b).

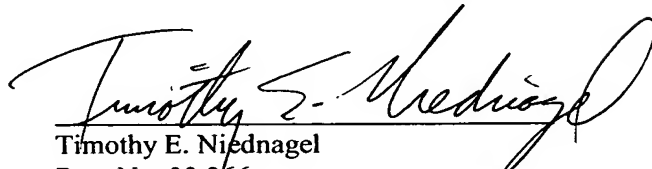
REMARKS

None of the art cited on the attached PTO Form 1449 is believed to disclose or suggest the invention recited in the claims of the above-identified application. It is therefore believed that the claimed invention is patentably distinguishable over these references.

Please charge any fees that might be due in connection with this Information Disclosure Statement to Bose McKinney & Evans LLP's Deposit Account No. 02-3223. An extra copy of this Information Disclosure Statement is enclosed for that purpose.

Respectfully submitted,

BOSE McKINNEY & EVANS LLP

  
Timothy E. Niednagel  
Reg. No. 33,266

Indianapolis, Indiana  
(317) 684-5000

387743



COPY OF PAPERS  
ORIGINALLY FILED

Sheet 1 of 3

FORM PTO-1449		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTY DOCKET NO. 8266-0738		SERIAL NO. 10/039,342	
INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary)				APPLICANT Borders et al.			
				FILING DATE January 8, 2002		GROUP 2632	
U.S. PATENT DOCUMENTS							
*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPLICABLE
	AA	4,237,344	12/02/1980	Moore			
	AB	4,275,385	06/23/1981	White			
	AC	4,577,060	03/18/1986	Webb et al.			
	AD	4,814,751	03/21/1989	Hawkins et al.			
	AE	4,940,963	07/10/1990	Gutman et al.			
	AF	4,968,966	11/06/1990	Jasinski et al.			
	AG	5,051,924	09/24/1991	Bergeron et al.			
	AH	5,227,776	07/13/1993	Starefoss			
	AI	5,291,399	03/01/1994	Chaco			
	AJ	5,465,082	11/07/1995	Chaco			
	AK	5,473,667	12/05/1995	Neustein			
FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO
	AL	DE 37 35295 A1	04/21/1988	Germany			xx
	AM	WO 92/09178	05/29/1992	WIPO			xx
	AN	WO 94/22098	09/29/1994	WIPO			xx
	AO	WO 95/15064	06/01/1995	WIPO			xx
	AP	WO 95/35634	12/28/1995	WIPO			xx
	AQ	WO 96/25738	08/22/1996	WIPO			xx
OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)							
	AR	IBM Technical Disclosure Bulletin, "Portable, Speech-Activated, Electronic Mail System", July 1995, Vol. 38 No. 07					
	AS	Swatch telecom, "Swatch Talk", 2/11/99, <a href="http://www.swatch.com/telecom/index.php3">http://www.swatch.com/telecom/index.php3</a>					
	AT	The Financial Post, "Watch Dick Tracy take the time to talk", July 4, 1998, pp. 7-8					
EXAMINER				DATE CONSIDERED			
*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.							

10/039342  
11/19/01

RECEIVED  
MAR 20 2002  
Technology Center 2600

FORM PTO-1449		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTY DOCKET NO. 8266-0738		SERIAL NO. 10/039,342	
<b>INFORMATION DISCLOSURE STATEMENT</b> <i>(Use several sheets if necessary)</i> <div style="border: 1px solid black; border-radius: 50%; width: 100px; height: 100px; display: flex; align-items: center; justify-content: center; margin: 10px auto;"> <div style="writing-mode: vertical-rl; transform: rotate(180deg); font-size: 8px;">PATENT &amp; TRADEMARK OFFICE</div> <div style="text-align: center;"> <b>MAR 14 2002</b> </div> </div>				APPLICANT Borders et al.			
				FILING DATE January 8, 2002		GROUP 2632	
<b>U.S. PATENT DOCUMENTS</b>							
*EXAMINER INITIAL	BA	DOCUMENT NUMBER 5,534,851	DATE 07/09/1996	NAME Russek	CLASS	SUBCLASS	FILING DATE IF APPLICABLE
	BB	5,537,459	07/16/1996	Price et al.			
	BC	5,561,412	10/01/1996	Novak et al.			
	BD	5,576,952	11/19/1996	Stutman et al.			
	BE	5,588,009	12/24/1996	Will			
	BF	5,699,038	12/16/1997	Ulrich et al.			
	BG	5,737,688	04/07/1998	Sakai et al.			
	BH	5,822,544	10/13/1998	Chaco et al.			
	BI	5,838,223	11/17/1998	Gallant et al.			
	BJ	5,872,505	02/16/1999	Wicks et al.			
	BK	5,970,387	10/19/1999	Yuan			
<b>FOREIGN PATENT DOCUMENTS</b>							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO
	BL	WO 97/15240	05/01/1997	WIPO			xx
	BM	WO 97/40640	10/30/1997	WIPO			xx
	BN						
	BO						
	BP						
	BQ						
<b>OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)</b>							
	BR	The Daily Telegraph, "Time ticks away for talking wristwatch". March 26, 1998					
	BS						
	BT						
EXAMINER					DATE CONSIDERED		
<small>*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.</small>							

**RECEIVED**  
**MAR 20 2002**  
 Technology Center 2600

FORM PTO-1449		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTY DOCKET NO. 8266-0738		SERIAL NO. 10/039,342	
INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary)				APPLICANT Borders et al.			
				FILING DATE January 8, 2002		GROUP 2632	
U.S. PATENT DOCUMENTS							
*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPLICABLE
	CA	5,973,613	10/26/1999	Reis et al.			
	CB	6,057,782	05/02/2000	Koenig			
	CC	6,085,069	07/04/2000	Sharpe			
	CD	6,141,531	10/31/2000	Williams et al.			
	CE	H1782	02/02/1999	Wicks et al.			
	CF						
	CG						
	CH						
	CI						
	CJ						
	CK						
FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO
	CL						
	CM						
	CN						
	CO						
	CP						
	CQ						
OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)							
	CR						
	CS						
	CT						
EXAMINER				DATE CONSIDERED			
*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609: Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.							

**Notice of References Cited**

*previous #  
parent Application*

Application/Control No.

09/187,696

Applicant(s)/Patent Under  
Reexamination  
BORDERS ET AL.

Examiner

Nina Tong

Art Unit

2632

Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS	DOCUMENT SOURCE **	
							APS	OTHER
<input type="checkbox"/>	A	H1782	Feb. 1999	Wicks et al.	340	825.44	<input checked="" type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	B	5872505	Feb. 1999	Wicks et al.	340	311.1	<input checked="" type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	C	5970387	Oct. 1999	Yuan	455	31.2	<input checked="" type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	D	6057782	May. 2000	Koenig	340	825.44	<input checked="" type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	E	4275385	Jun. 1981	White	340	825.44	<input checked="" type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	F	5973613	Oct. 1999	Reis et al.	340	825.44	<input checked="" type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	G	6141531	Oct. 2000	Willaims et al.	455	555	<input checked="" type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	H	6085069	Jul. 2000	sharpe	455	31.3	<input checked="" type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	I	4577060	Mar. 1986	Webb et al.	--	--	<input checked="" type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	J	5576952	Nov. 1996	Stutman et al.	--	--	<input checked="" type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	K	5534851	Jul. 1996	Russek	340	573.1	<input checked="" type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	L						<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	M						<input type="checkbox"/>	<input type="checkbox"/>

**FOREIGN PATENT DOCUMENTS**

*		DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS	DOCUMENT SOURCE **	
								APS	OTHER
<input type="checkbox"/>	N							<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	O							<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	P							<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	Q							<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	R							<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	S							<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	T							<input type="checkbox"/>	<input type="checkbox"/>

**NON-PATENT DOCUMENTS**

*		DOCUMENT (Including Author, Title Date, Source, and Pertinent Pages)	DOCUMENT SOURCE **	
			APS	OTHER
<input type="checkbox"/>	U		<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	V		<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	W		<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	X		<input type="checkbox"/>	<input type="checkbox"/>

\*A copy of this reference is not being furnished with this Office action. (See Manual of Patent Examining Procedure, Section 707.05(a).)

\*\*APS encompasses any electronic search i.e. text, image, and Commercial Databases.

U.S. Patent and Trademark Office

PTO-892 (Rev. 03-98)

Notice of References Cited

Part of Paper No. 11

<b>Notice of References Cited</b>	Application/Control No. 09/187,696	Applicant(s)/Patent Under Reexamination BORDERS ET AL.	
	Examiner Nina Tong	Art Unit 2632	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification	
	A	US-5473667	12-1995	Neustein	379	57
	B	US-5737688	04-1998	Sakai et al.	455	31.2
	C	US-5973613	10-1999	Reis et al.	340	825.44
	D	US-4968966	11-1990	Jasinski et al.	340	825.44
	E	US-				
	F	US-				
	G	US-				
	H	US-				
	I	US-				
	J	US-				
	K	US-				
	L	US-				
	M	US-				

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification	
	N						
	O						
	P						
	Q						
	R						
	S						
	T						

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

Art Unit: 2736

## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-27, drawn to the system for paging members of a medical team, classified in class 340, subclass 286.07.
  - II. Claims 28-64, drawn to the integrated personal communication and data entry device, classified in class 340, subclass 573.1.
2. Inventions Group I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because group I is related to the paging system with a communication device. The subcombination has separate utility such as the communication device could be used alone for any system.



Art Unit: 2736

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. If the applicant selected the **Group II**, then this application contains claims directed to the following patentably distinct species of the claimed invention:

Species I (claims 28-49): the communication device with the paging device and the voice recording.

Species II (claims 50-57): the communication device with the paging device and the cellular phone transceiver/any radio transceiver.

Species III (claims 58-64): the communication device with the paging and infrared transmitter.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there is no generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

Art Unit: 2736

thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. A telephone call was made to Timothy E. Niednagel on 09/29/00 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 2736

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nina Tong whose telephone number is (703) 305-4831. The examiner can normally be reached on Mon. to Thurs. from 8:30a.m. to 6:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery Hofsass, can be reached on (703) 305-4717.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-8576.

8. **Any response to this action should be mailed to :**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703)308-9051, (for formal communication intended for entry)

**Or:**

(703)308-6743 (for informal or draft communications, please label  
“UNOFFICIAL” OR “INFORMAL” OR “PROPOSED” or “DRAFT”)

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

Application/Control Number: 09/187,696

Page 6

Art Unit: 2736

Nina Tong  
September 16, 2003

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1 line 6, change “a plurality of pagers” to –said plurality of pagers--.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,6,10,20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Gutman et al. (4,940,963 from PTOL-1449 paper no.4).

Regarding claims 1,6,10,20-23, the phrase “medical team” in the preamble is considered intended use since the claimed limitation does not provide the detail of how the paging system is applied in the medial team. Thus no patentable weight is given.

Art Unit: 2632

Gutman et al. Discloses a paging system with improved acknowledge-back capabilities, which comprises a paging transceiver 22 (as paging system) for transmitting signals to a plurality of pagers 24 which provides an acknowledge signal back automatically and manually. The two-ways pager inherently included the cellular transceiver. Also, the memory and the display are inherently included in the pagers to display any information. In addition, one of the pager form (24b) includes inputs for transmit any information back.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,6-10,24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutman et al. (4,940,963 from PTOL-1449 paper no.4).

Regarding claims 1,6,24-27, Gutman et al. Discloses a paging system with improved acknowledge-back capabilities, which comprises a paging transceiver 22 (as paging system) for transmitting signals to a plurality of pagers 24 which provides an acknowledge signal back automatically and manually. If the user did not send the acknowledge signal within the preset time, the pager will send a negative signal out.

Gutman et al. Fails to specify the claimed medical team.

However, as long as the function of such a paging system is the same, employing such a paging system in any environment, such as the claimed medical team, would not constitute an inventive step but an obvious design choice. Also, it is well-known in the art of employing any well-known communication system, such as paging system, in the medical environment area for time consuming. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the paging system of Gutman et al. in any environment, such as the claimed medical team, for performing the same function as desired with the above shown reasons.

Regarding claims 7-9, it is well-known in the art of employing different frequency or channels to transmit signals/data to different group of communication unit, such as tags, transceivers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ different frequency to transmit signals to different group of pagers in Gutman et al. for preventing any false communication and signals collision.

Regarding claims 24-26, as long as the pager is function the same, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ any well-known attachment means in the pager for the user to easy carry it around, such as in the necklace form, in the belt form, in the hand watch form, in Gutman et al. for preventing the user forget to carry the pager or to lose the pager.

Regarding claim 27, as long as the pager function the same, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ any housing form, such as the claimed flexible sterile sheath configured to surround the pager, in Gutman et al. for protecting the pager and for easy carry around.

6. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutman et al. (4,940,963 from PTOL-1449 paper no.4) in view of Williams et al. (6,141,531) .

Regarding claims 2-5, Williams et al. shows the local wireless communication system with the transmission method that 1) if the transceivers are within range, they can communicate directly; 2) if the transceivers are out of range, they can communicate via the repeater. It would have been obvious to one of ordinary skill in the art of employing the local communication method as shown above & as taught by Williams et al. in the paging system of Gutman et al. for improving the communication system to confirm the recipient receiving the message.

7. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutman et al. (4,940,963 from PTOL-1449 paper no.4) in view of White (4,275,385) .

Regarding claims 11-13, White teaches the concept of employing the infrared locating system for locating the personnel transmitter and then send the signals to the transmitter at the sensed location. Each transmitter transmits the infrared ID code to each receiver in each monitor area whenever it enters an area. It would have been obvious to one of ordinary skill in the art at



the time the invention was made to employ the above infrared locating system in the paging system of Gutman et al. for improving the system such that the pagers could be located and to confirm the pagers received the emergency messages.

8. Claims 14,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutman et al. (4,940,963 from PTOL-1449 paper no.4) in view of White (4,275,385) as applied to claims 11-13 above, and further in view of Koenig (6,057,782).

Regarding claims 14,15, Koenig teaches the concept of transmitting the signals to a substitute pager when the original pager did not send the positive acknowledge signal back. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teaching of Koenig for transmitting the signals to a substitute pager when the original pager did not send the positive acknowledge signal back in the above combination for ensuring the user receive the signals.

9. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutman et al. (4,940,963 from PTOL-1449 paper no.4) in view of Yuan (5,970,387) .

Regarding claims 16-19, Yuan shows the well-known voice and digital pager. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ any well-known pager, such as the voice and digital pager, as shown by Yuan in the paging system of Gutman et al. for improving the paging system.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. Claims 1,2,4,6,10,20,21,23,26 are rejected under 35 U.S.C. 102(e) as being anticipated by Wicks et al. (5,872,505).

Regarding claims 1,2,4,6,10,20,21,23,26, the phrase “medical team” in the preamble is considered intended use since the claimed limitation does not provide the detail of how the paging system is applied in the medial team. Thus, no patentable weight is given.

Wicks et al. discloses a paging system with improved acknowledge-back capabilities, which comprises a paging for transmitting signals to a plurality of pagers that are within the ranges and the pagers provides an acknowledge signal back (fig.1 and col.1 lines 19-44). The display for displaying patient information in the pager (40). Also, the two-way pagers inherently included the cellular transceiver. The pager could be in necklace form.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 7-9,24-27, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al. (5,872,505).

Regarding claims 7-9, it is well-known in the art of employing different frequency or channels to transmit signals/data to different group of communication unit, such as tags, transceivers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ different frequency to transmit signals to different group of pagers in Wicks et al. for preventing any false communication and signals collision.

Regarding claims 24-26, as long as the pager is function the same, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ any well-known attachment means in the pager for the user to easy carry it around, such as in the necklace form, in the belt form, in the hand watch form, in Wicks et al. for preventing the user forget to carry the pager or to lose the pager.

Regarding claim 27, as long as the pager function the same, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ any housing form, such as the claimed flexible sterile sheath configured to surround the pager, in Wicks et al. for protecting the pager and for easy carry around.

14. Claims 3,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al. (5,872,505) in view of Williams et al. (6,141,531) .

Regarding claims 3,5, Williams et al. shows the local wireless communication system with the transmission method that 1) if the transceivers are within range, they can communicate directly; 2) if the transceivers are out of range, they can communicate via the repeater. It would have been obvious to one of ordinary skill in the art of employing the repeaters for transmitting the signals to the pagers that are out of the range as taught by Williams et al. in the paging system of Wicks et al. for improving the communication system to confirm the recipient receiving the message.

15. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al. (5,872,505) in view of White (4,275,385).

Regarding claims 11-13, White teaches the concept of employing the infrared locating system for locating the personnel transmitter and then send the signals to the transmitter at the sensed location. Each transmitter transmits the infrared ID code to each receiver in each monitor

Art Unit: 2632

area whenever it enters an area. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the above infrared locating system in the paging system of Wicks et al. for improving the system such that the pagers could be located and to confirm the pagers received the emergency messages.

16. Claims 14,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al. (5,872,505) in view of White (4,275,385) as applied to claims 11-13 above, and further in view of Koenig (6,057,782).

Regarding claims 14,15, Koenig teaches the concept of transmitting the signals to a substitute pager when the original pager did not send the positive acknowledge signal back. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teaching of Koenig for transmitting the signals to a substitute pager when the original pager did not send the positive acknowledge signal back in the above combination for ensuring the user receive the signals.

17. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al. (5,872,505) in view of Yuan (5,970,387) .

Regarding claims 16-19, Yuan shows the well-known voice and digital pager. It would have been obvious to one of ordinary skill in the art at the time the invention was made to

employ any well-known pager, such as the voice and digital pager, as shown by Yuan in the paging system of Wicks et al. for improving the paging system.

18. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al. (5,872,505) in view of Wicks et al. (H1782).

Regarding claim 22, Wicks H1782 teaches the concept of providing a pager with a transmitter and inputs such that the patients can transmit health-related information back to his or her health care provider. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have pagers including the transmitter and input as taught by Wicks H1782 in Wicks '505 for enabling the patients to transmit any information or health information to the medical personnel or station for safety.

### ***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sharpe disclosed the well-known two-way pagers fig.1.

Reis et al. disclosed a pager repeater system.

Webb et al. disclosed a paging network.

Russek disclosed an alarm and patient monitor and life support equipment with paging system.

Stutman et al. disclosed a medical alert distribution system with wireless communication system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nina Tong whose telephone number is 703-305-4831. The examiner can normally be reached on Mon-Fri. (9:30 -7:00), alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on 703-305-4717. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-6743 for regular communications and 703-308-6743 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Nina Tong  
Primary Examiner  
Art Unit 2632

Nina Tong  
September 16, 2003

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 65,6-10,24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutman et al. (4,940,963 from PTOL-1449 paper no.4) in view of Reis et al. (5,973,613).

Regarding claims 65,6,24-27, Gutman et al. Discloses a paging system with improved acknowledge-back capabilities, which comprises a paging transceiver 22 (as paging system) for transmitting signals to a plurality of pagers 24 which provides an acknowledge signal back automatically and manually. If the user did not send the acknowledge signal within the preset time, the pager will send a negative signal out.

Gutman et al. Fails to specify the claimed medical team.

However, as long as the function of such a paging system is the same, employing such a paging system in any environment, such as the claimed medical team, would not constitute an inventive step but an obvious design choice. Also, it is well-known in the art of employing any well-known communication system, such as paging system, in the medical



Art Unit: 2632

environment area for time consuming. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the paging system of Gutman et al. in any environment, such as the claimed medical team, for performing the same function as desired with the above shown reasons.

Gutman et al. fails to specify the claimed transmitting the predefined paging signal to a plurality of pagers simultaneously. However, it is well-known in the art of providing a one-to-many communication paging system as shown by Reis et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the well-known one-to-many communication paging method in the above combination as taught by Reis et al. for sending the predefined paging signal to a plurality of pagers in the medical team simultaneously for convenience and faster.

Regarding claims 7-9, it is well-known in the art of employing different frequency or channels to transmit signals/data to different group of communication unit, such as tags, transceivers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ different frequency to transmit signals to different group of pagers in Gutman et al. for preventing any false communication and signals collision.

Regarding claims 24-26, as long as the pager is function the same, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ any well-known attachment means in the pager for the user to easy carry it around, such as in the necklace

form, in the belt form, in the hand watch form, in Gutman et al. for preventing the user forget to carry the pager or to lose the pager.

Regarding claim 27, as long as the pager function the same, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ any housing form, such as the claimed flexible sterile sheath configured to surround the pager, in Gutman et al. for protecting the pager and for easy carry around.

3. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutman et al. in view of Reis et al. as applied to claim 65 above, and further in view of Williams et al. (6,141,531).

Regarding claims 2-5, Williams et al. shows the local wireless communication system with the transmission method that 1) if the transceivers are within range, they can communicate directly; 2) if the transceivers are out of range, they can communicate via the repeater. It would have been obvious to one of ordinary skill in the art of employing the local communication method as shown above & as taught by Williams et al. in the paging system of Gutman et al. in the above combination for improving the communication system to confirm the recipient receiving the message.

4. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutman et al. in view of Reis et al. as applied to claim 65 above, and further in view of White (4,275,385).

Regarding claims 11-13, White teaches the concept of employing the infrared locating system for locating the personnel transmitter and then send the signals to the transmitter at the sensed location. Each transmitter transmits the infrared ID code to each receiver in each monitor area whenever it enters an area. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the above infrared locating system in the above combination for improving the system such that the pagers could be located and to confirm the pagers received the emergency messages.

5. Claims 14,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutman et al. (4,940,963 from PTOL-1449 paper no.4) in view of Reis et al. (5,973,613) and further in view of White (4,275,385) as applied to claims 11-13 above, and further in view of Koenig (6,057,782).

Regarding claims 14,15, Koenig teaches the concept of transmitting the signals to a substitute pager when the original pager did not send the positive acknowledge signal back. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teaching of Koenig for transmitting the signals to a substitute pager when the original pager did not send the positive acknowledge signal back in the above combination for ensuring the user receive the signals.

6. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutman et al. (4,940,963 from PTOL-1449 paper no.4) in view of Reis et al. (5,973,613) as applied to claim 65 above, and further in view of Yuan (5,970,387) .

Regarding claims 16-19, Yuan shows the well-known voice and digital pager. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ any well-known pager, such as the voice and digital pager, as shown by Yuan in the above combination for improving the paging system.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 65,2,4,6-10,20,21,23,24-27, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al. (5,872,505) in view of Reis et al. (5,973,613).

Regarding claims 65,2,4,6,10,20,21,23,26, Wicks et al. discloses a paging system with improved acknowledge-back capabilities, which comprises a paging for transmitting signals to a plurality of pagers that are within the ranges and the pagers provides an acknowledge signal back (fig.1 and col.1 lines 19-44). The display for displaying patient information in the pager (40). Also, the two-way pagers inherently included the cellular transceiver. The pager could be in necklace form.

Wicks et al. Fails to specify the claimed medical team.

However, as long as the function of such a paging system is the same, employing such a paging system in any environment, such as the claimed medical team, would not constitute an inventive step but an obvious design choice. Also, it is well-known in the art of employing any well-known communication system, such as paging system, in the medical-environment area for time consuming. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the paging system of Wicks et al. in any environment, such as the claimed medical team, for performing the same function as desired with the above shown reasons.

Wicks et al. fails to specify the claimed transmitting the predefined paging signal to a plurality of pagers simultaneously. However, it is well-known in the art of providing a one-to-many communication paging system as shown by Reis et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the well-known one-to-many communication paging method in the above combination as taught by Reis et al. for sending the predefined paging signal to a plurality of pagers in the medical team simultaneously for convenience and faster.

Regarding claims 7-9, it is well-known in the art of employing different frequency or channels to transmit signals/data to different group of communication unit, such as tags, transceivers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ different frequency to transmit signals to different group of pagers in the above combination for preventing any false communication and signals collision.

Regarding claims 24-26, as long as the pager is function the same, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ any well-known attachment means in the pager for the user to easy carry it around, such as in the necklace form, in the belt form, in the hand watch form, in the above combination for preventing the user forget to carry the pager or to lose the pager.

Regarding claim 27, as long as the pager function the same, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ any housing form, such as the claimed flexible sterile sheath configured to surround the pager, in the above combination for protecting the pager and for easy carry around.

9. Claims 3,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al. (5,872,505) in view of Reis et al. (5,973,613) as applied in claim 65 above, and further in view of Willaims et al. (6,141,531) .

Regarding claims 3,5, Williams et al. shows the local wireless communication system with the transmission method that 1) if the transceivers are within range, they can communicate directly; 2) if the transceivers are out of range, they can communicate via the repeater. It would have been obvious to one of ordinary skill in the art of employing the repeaters for transmitting the signals to the pagers that are out of the range as taught by Williams et al. in the above combination for improving the communication system to confirm the recipient receiving the message.

10. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al. (5,872,505) in view of Reis et al. (5,973,613) as applied in claim 65 above, and further in view of White (4,275,385).

Regarding claims 11-13, White teaches the concept of employing the infrared locating system for locating the personnel transmitter and then send the signals to the transmitter at the sensed location. Each transmitter transmits the infrared ID code to each receiver in each monitor area whenever it enters an area. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the above infrared locating system in the above combination for improving the system such that the pagers could be located and to confirm the pagers received the emergency messages.

11. Claims 14,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al. (5,872,505) in view of Reis et al. (5,973,613) and further in view of White (4,275,385) as applied to claims 11-13 above, and further in view of Koenig (6,057,782).

Regarding claims 14,15, Koenig teaches the concept of transmitting the signals to a substitute pager when the original pager did not send the positive acknowledge signal back. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teaching of Koenig for transmitting the signals to a substitute pager when the original

pager did not send the positive acknowledge signal back in the above combination for ensuring the user receive the signals.

12. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al. (5,872,505) in view of Reis et al. (5,973,613) as applied in claim 65 above, and further in view of Yuan (5,970,387) .

Regarding claims 16-19, Yuan shows the well-known voice and digital pager. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ any well-known pager, such as the voice and digital pager, as shown by Yuan in the above combination for improving the paging system.

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al. (5,872,505) in view of Reis et al. (5,973,613) as applied in claim 65 above, and further in view of Wicks et al. (H1782).

Regarding claim 22, Wicks H1782 teaches the concept of providing a pager with a transmitter and inputs such that the patients can transmit health-related information back to his or her health care provider. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have pagers including the transmitter and input as taught by Wicks H1782 in the above combination for enabling the patients to transmit any information or health information to the medical personnel or station for safety.



***Response to Arguments***

14. Applicant's arguments with respect to claims 65,2-27 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sakai et al. and Neustein disclosed a paging system with one-to-many communication system/method.

Jasinski et al. disclosed the well-known method of a plurality of pagers sending the acknowledge signals back to the center.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nina Tong whose telephone number is 703-305-4831. The examiner can normally be reached on Mon-Fri. (9:30 -7:00), alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on 703-305-4717. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Nina Tong  
Primary Examiner  
Art Unit 2632

Nina Tong  
September 16, 2003

*Regarding applicant's arguments, the applicant argued that the Gutman relates to a paging system with improved acknowledge-back capabilities. Gutman discloses different types of pagers 24a,b,c, which may be used in the system. However, Gutman does not disclose or suggest a predefined paging signal for a plurality of pagers corresponding to a medical team or a dispatch system to page each of the plurality of pagers simultaneously using the predefined paging signal. In Gutman, paging calls are transmitted to only a single pager.*

*Reis also does not disclose or suggest a predefined paging signal for a plurality of pagers corresponding to a medical team or a dispatch system to page each of the plurality of pagers simultaneously using the predefined paging signal. Ries discloses a communication system which communicates pagers using either one-to-many commands ("broadcast commands") or one-to-one commands ("directed commands"). The broadcast commands are broadcast for execution by all awake pagers. The directed commands are commands directed to a single addressed pager for execution.*

*The present invention does not broadcast to all awake pagers or only to a single pager. The paging dispatch system of claim 65 includes a transmitter configured to broadcast the predefined paging signal to page simultaneously only the plurality of pagers assigned to the medical team members when it is desired to assemble the medical team. The transmitter of the present invention does not transmit the predefined paging signal to all awake pagers or only to one pager as in Reis.*

*The present invention transmits the predefined paging signal to a specific group of pagers assigned to the medical team simultaneously, without broadcasting to all awake pagers, to facilities assembly of the medical team. For at least these reasons, applicants submit that the*

*combination of Gutman and Reis does not disclose or suggest the combination claimed in independent claim 65.*

*In addition, Wicks relates to a medication alert pager and paging system. Wicks discloses transmitting a reminder to a pager 40 from a base station 43. Wicks does not disclose or suggest a dispatch system configured to broadcast a predefined paging signal corresponding to the medical team to page a plurality of pagers simultaneously as recited in independent claim 65. In Wicks, paging calls are transmitted to a single pager.*

However, the Examiner disagreed. The Examiner already admitted that the reference to Gutman et al. fails to specify the claimed transmitting the predefined paging signal to a plurality of pagers simultaneously. The Examiner had used the reference to Reis to teach the well-known one-to-many communication paging system. Also, in the claim, the claim did not specifically mention that the predefined paging signals is only transmitted to a particular group of pagers among a plurality group of pagers. Here the reference shows a paging signal to a predetermined group of pagers within an area. If all the medical team members are working within one particular floor or building, the signal could only broadcast to all the pagers within that particular floor or building. In addition, it is well-known in the art of broadcasting/paging signal to a predefined group of pagers or tags. Also the term “predefined paging signal” is very broad and did not specify the type/function of the paging signal. Moreover, the Examiner also already admitted that the reference to Wick et al. fails to specify the claimed transmitting the predefined paging signal to a plurality of pagers simultaneously. The Examiner had used the reference to

Art Unit: 2632

Reis to teach the well-known one-to-many communication paging system. Also, in the claim, the claim did not specifically mention that the predefined paging signals is only transmitted to a particular group of pagers among a plurality group of pagers. Here the reference shows a paging signal to a predetermined group of pagers within an area. If all the medical team members are working within one particular floor or building, the signal could only broadcast to all the pagers within that particular floor or building. In addition, it is well-known in the art of broadcasting/paging signal to a predefined group of pagers or tags.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nina Tong whose telephone number is 703-305-4831. The examiner can normally be reached on Mon-Fri. (9:30 -7:00), alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on 703-305-4717. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Nina Tong  
Primary Examiner  
Art Unit 2632

Nina Tong  
September 16, 2003